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Smiley

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/315,882 09/30/94 BARRIE

12M2/0412

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S	604291
EXAMINER	
RIZZO, N	
ART UNIT	PAPER NUMBER

1202
DATE MAILED:

04/12/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ _____

Part II SUMMARY OF ACTION

- ☒ Claims 1-25 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
- ☐ Claims _____ have been cancelled.
- ☐ Claims _____ are allowed.
- ☒ Claims 1-25 are rejected.
- ☐ Claims _____ are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Art Unit 1202

The claims are 1-~~25~~.

All of the claims are rejected as unpatentable over Wicha et al. (Ref. Ar). (35 USC 103) Note the clear teaching of the substitution of "pyridyl" at the 17 position of the ring. This represents the gist of what is being claimed. The lack of selectivity is emphasized by the extensive scope of the claimed compounds. The exclusion found at the end of instant claim 1 fails to distinguish the compounds patentably because there is no evidence of record to demonstrate that as a class the remaining compounds are patentable. In re Susi, 169 USPQ 429. It is well known that steroidal activity cannot be easily predicted without sufficient evidence to document the extrapolation to compounds not actually tested. Thus, the disclosure in the Bulletin of the Polish Academy establishes a strong "prima facie" case of obviousness, because of the compounds it discloses. In re Payne 203 USPQ 249.

Claims 1 and 17 are rejected as failing to comply with 35 USC 112, 2nd paragraph. The term "general" leaves the claims open to unstated substituents. Ambiguities should be resolved during pendency in the PTO. In re Hammack, 166 USPQ 409.

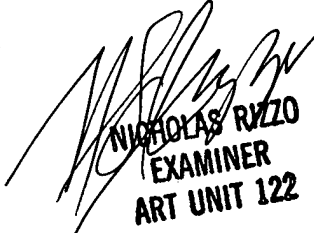
Serial No. 08/315,882

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Art Unit 1202

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RIZZO:jd
April 10, 1995


NICHOLAS RIZZO
EXAMINER
ART UNIT 122